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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,591	07/17/2000	Jeffrey D. Pierce	E-995	7499

7590

01/16/2003

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EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,591

Applicant(s)

PIERCE, JEFFREY D.

Examiner

Edward R. Cosimano

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The use of various trademark "ClickStamp Online™" in the paragraph:

A) at page 1, lines 8-22, Recently a new way ... ClickStamp Online™ which enables mailers to print IBIP type indicia using their own digital printers."; has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(4) because reference characters "22" and "23" have both been used to designate an item of mail as can be seen in figs. 1, 2, 3, 5 & 6, and from the context of the paragraph:

(a) at page 5, lines 2-9, "Figure 1 shows system 10 ... envelopes 22. Memory 20 ...need to change the application software.";

(b) at page 5, lines 17-24, "Figure 2 shows mailpeice 22 ... manner. Envelope 23 functions ... graphic portion G which ... as the well known PDF 417 format.";

(c) between page 5, line 25, and page 6, line 2, "Envelope 23 has ... 22U. Envelope 23 also ... and lies along edge 22U.";

(d) at page 6, lines 7-19, "From the width W and the height H of envelope 23 ... envelope 23 ... envelope 23 ... does not need to be discussed here)."; and

(e) at page 6, lines 20-24, "Figure 3 shows ... envelope 23. New ... reserved clear area F."

(2) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(a) as can be seen in fig. 2, and from the context of the paragraph:

(a)(1) at page 5, lines 17-24, "Figure 2 shows mailpeice 22 ... manner. Envelope 23 functions ... graphic portion G which ... as the well known PDF 417 format."; and

(a)(2) at page 6, lines 3-6, "Typically, in the prior ... potion G is ... F. Portions HR and G have height d4."; fig. 2 lacks reference legend "G".

(3) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

(a) 28, 30 & 32 of fig. 2 as this figure is being described in the paragraphs between page 4, line 17, and page 6, line 19, "Figure 2 shows ... does not need to be discussed here).".

(4) as can be seen in fig. 1 and fro the context of the paragraph at page 5, lines 2-9, "Figure 1 shows system 10 ... envelopes 22. Memory 20 ...need to change the application software."; in fig. 1, "23" should be -22--.

3.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

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4. The disclosure is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 28, 30 & 32 of fig. 2 as this figure is being described in the paragraphs between page 4, line 17, and page 6, line 19, "Figure 2 shows ... does not need to be discussed here)."

In this regard, it is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) the following errors have been noted in the specification:

(1) the description of figs. 1, 2, 3, 5 & 6 uses both reference numbers "22" and "23" to designate an item of mail as can be seen in the context of the paragraph:

(a) at page 5, lines 2-9, "Figure 1 shows system 10 ... envelopes 22. Memory 20 ...need to change the application software.";

(b) at page 5, lines 17-24, "Figure 2 shows mailpiece 22 ... manner. Envelope 23 functions ... graphic portion G which ... as the well known PDF 417 format.";

(c) between page 5, line 25, and page 6, line 2, "Envelope 23 has ... 22U. Envelope 23 also ... and lies along edge 22U.";

(d) at page 6, lines 7-19, "From the width W and the height H of envelope 23 ... envelope 23 ... envelope 23 ... does not need to be discussed here)."; and

(e) at page 6, lines 20-24, "Figure 3 shows ... envelope 23. New ... reserved clear area F."

Appropriate correction is required.

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5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. This application is in condition for allowance except for the following formal matters:

A) See above.

6.1 Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

6.2 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 2 (TWO) MONTHS FROM THE DATE OF THIS LETTER.

7. The following is an Examiner's Statement of Reasons for Allowance:

A) the prior art, for example:

(1) Heiden (6,408,286) discloses that an envelope is divided into various areas, where some of the areas are designated by the Post Office for various types of information, FIM, indicia, bar codes, etc. and free space that may be used for other purposes.

(2) Miller et al (6,461,063), which discloses that the postage indicia needs to be printed so as to not interfere with FIM markings on an item of mail.

B) however in regard to claims 1, 7 & 13, the prior art does not teach or suggest:

(1) determining the printable and unprintable areas of an item of mail;

(2) determining if the designated location of the postage indicia would overlap an unprintable area;

(3) printing the postage indicia at the designated location of the indicia, if the designated location does not overlap an unprintable area; and

(4) printing the postage indicia after shifting the location of the postage indicia so as to not overlap the unprintable area when the designated location of the postage indicia overlaps an unprintable area.

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Claims 2-6, 8-12 & 14-18 area allowable for the same reason.

7.1 Any comments considered necessary by applicant must be submitted no later than the payment of the Issue Fee and, to avoid processing delays, should preferably **accompany** the Issue Fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. The examiner has cited prior art of interest, for example:

A) Linkowski et al (4,843,572), which discloses the ability of adjusting the location of the postage indicia relative to the leading edge of the item of mail.

B) Gil (4,868,757), which discloses using a printer capable of printing the indicia in the proper location based on the size and thickness of the item of mail.

C) Kara (WO 97/14117), which discloses locating the postage indicia in the proper position to be visible through a window in the mailing envelope.

D) Terrell, which disclose the use of a digital postage indicia in stead of a stamp.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

01/13/03


Edward R. Cosimano
Primary Examiner A.U. 3629